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VP

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/212,270	12/16/98	TRIBOULEY	C 02441.77733

CHIRON CORPORATION  
INTELLECTUAL PROPERTY R440  
P O BOX 8097  
EMERYVILLE CA 94662-8097

HM12/1102

EXAMINER

O HARA, E

ART UNIT	PAPER NUMBER
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1646

DATE MAILED:

11/02/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/212,270

Applicant(s)

Tribouley et al.

Examiner

Eileen B. O'Hara

Group Art Unit  
1646



☒ Responsive to communication(s) filed on Aug 24, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-16 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 4 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-16 were ~~are~~ subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 1646

### **DETAILED ACTION**

1. Claims 1-16 are pending in the instant application. In a response filed Aug. 24, 1999, paper No. 10, to an office action mailed June 21, 1999, Applicant elected with traverse to prosecute the invention of Group III, claim 4, directed to antibodies which specifically bind to a protein having an amino acid sequence of SEQ ID NO:1.
2. Applicant's election with traverse of Group III, claim 4, in Paper No. 10 is acknowledged. The traversal is on the ground(s) that as the groups are in the same class and subclass, a search would not present an undue burden on the Examiner. This is not found persuasive because as the antibodies are directed towards two patentably distinct proteins, they would require separate literature searches and would be a burden.

The requirement is still deemed proper and is therefore made FINAL.

Therefore, Group III, claim 4, directed to antibodies which specifically bind to the protein having the amino acid sequences of SEQ ID NO: 1 will be examined upon the merits.

Claims 1-3, 4 ( as far as it is drawn to antibodies which specifically bind to a protein having an amino acid sequence of SEQ ID NO:2) and 5-16 have been withdrawn to a non-elected invention by the examiner.

Art Unit: 1646

***Double Patenting***

3. Claim 4 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 4 of copending Application No. 09/286,529. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eileen B. O'Hara, whose telephone number is (703) 308-3312. The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell can be reached at (703) 308-4310.

Official papers filed by fax should be directed to (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Eileen B. O'Hara, Ph.D



Patent Examiner

  
**PAULA K. HUTZELL**  
**SUPERVISORY PATENT EXAMINER**